

REMARKS

Claims 1, 56-63, 67-75, 79 and 82-88 were pending and under consideration in the instant application. With this Response, no claims have been cancelled or amended. Claims 1, 56-63, 67-75, 79 and 82-88 remain pending and under consideration.

I. DOUBLE PATENTING

a. Statutory Type Double Patenting

Claims 1, 56-63, 67-75, 84, 86 and 88 stand rejected under statutory type double patenting in accordance with 35 U.S.C. §101 as allegedly claiming the same invention as U.S. Application No. 09/453,841, now issued U.S. Patent No. 6,573,239. Applicants respectfully disagree.

The determination of whether a statutory basis exists for a double patenting rejection is whether the same invention is being claimed twice. 'Same invention' means identical subject matter. MPEP § 804.II.A. citing *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957) emphasis added. The subject matter of the present application ("the '718 application") and U.S. Patent No. 6,573,239 ("the '239 patent") are not identical.

Independent Claim 1 of the '239 patent and independent Claim 1 of the '718 application both recite, *inter alia*, formula I. The residues comprising formula I for these two claims are provided below.

Residue number	The '239 patent	The '718 application
X ₁	Pro (P), Ala (A), Gly (G), Gln (Q), Asn (N), Asp (D) or D-Pro (p)	Pro (P), Ala (A), Gly (G), Gln (Q), Asn (N), Asp (D) or D-Pro (p)
X ₂	aliphatic	aliphatic
X ₃	Leu (L) or Phe (F)	Leu (L) or Phe (F)
X ₄	acidic	Glu (E)
X ₅	Leu (L) or Phe (F)	aliphatic
X ₆	Leu (L) or Phe (F)	Leu (L) or Phe (F)
X ₇	hydrophilic	Glu (E) or Leu (L)
X ₈	acidic or basic	Asn (N) or Gln (Q)
X ₉	Leu (L) or Gly (G)	Leu (L)

X ₁₀	Leu (L), Trp (W) or Gly (G)	Leu (L), Trp (W) or Gly (G)
X ₁₁	hydrophilic	acidic
X ₁₂	hydrophilic	Arg (R)
X ₁₃	Gly (G) or aliphatic	Leu (L) or Gly (G)
X ₁₄	Leu (L), Trp (W), Gly (G) or Nal	Leu (L), Phe (F) or Gly (G)
X ₁₅	hydrophilic	Asp (D)
X ₁₆	hydrophobic	Ala (A)
X ₁₇	hydrophobic	Leu (L)
X ₁₈	Gln (Q), Asn (N) or basic	Asn (N) or Gln (Q)
X ₁₉	Gln (Q), Asn (N) or basic	basic
X ₂₀	basic	basic
X ₂₁	aliphatic	Leu (L)
X ₂₂	basic	basic
X ₂₃	absent or basic	absent or basic

Applicants submit that formula I of the '239 patent and the '718 application differ in the residues at positions X₄, X₅, X₇-X₉, X₁₁-X₁₉ and X₂₁. For example, at position 8, the '239 patent recites an acidic or basic residue while the '718 application recites Asn (N) or Gln (Q). The specification of both the '239 patent and the '718 application describe acidic residues as referring to Glu (E) and Asp (D) and basic residues as referring to His (H), Arg (R) and Lys (K). (the '718 application at page 41, lines 7 to 17; the '239 patent at col. 24, line 63 to col. 25, line 6).

The composition of formula I for the '239 patent is not identical to formula I recited in the present application. Applicants respectfully request that the rejection be withdrawn.

b. Obviousness-Type Double Patenting

Claims 85 and 87 stand rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over Claims 19-21 of U.S. Patent No. 6,573,329. Claims 82 and 83 stand rejected under the judicially created doctrine of obviousness-type double patenting as being allegedly unpatentable over Claims 26 and 31-34 of U.S. Patent No. 6,573,329.

Applicants submit that the double patenting rejection is improper in light of the differences between the '239 patent and the present application, as discussed above.

Applicants respectfully request that the rejection, if any, be withdrawn.


CONCLUSION

Applicants submit that Claims 1, 56-63, 67-75, 79 and 82-88 satisfy all the criteria for patentability and are in condition for allowance. An early indication of the same is therefore kindly solicited.

No fee is believed due with this response. However, pursuant to 37 C.F.R. §1.136 (a)(3), the Commissioner is authorized to charge all required fees, fees under 37 C.F.R. §1.17 and all required extension of time fees, or credit any overpayment, to Pennie & Edmonds LLP, U.S. Deposit Account No. 16-1150 (Order No. 9196-018-999).

Respectfully submitted,

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